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In re Application of:

Klinkert, Deborah A. et al

Appl. No.: 10/765,708

Filed: Jan. 27, 2004

Attorney Docket No. 20067.0021US01

For: EXHAUST ASSEMBLY

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: DECISION ON PETITION
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This is a decision on the petition filed on Dec. 18, 2007 by which petitioners request supervisory review and withdrawal of the finality of the office action dated Nov. 21, 2007. The petition is considered pursuant to 37 CFR § 1.181, and no fee is required.

The petition is dismissed.

A review of the relevant prosecution history shows that the applicant filed a RCE on Oct. 31, 2007 with amendments to dependent claims 3, 4 and independent claim 17 and with the addition of new dependent claims 22-24. The RCE was properly filed in accordance with the 35 U.S.C. § 132(b) and MPEP § 706.07(h). On Nov. 21, 2007, the examiner issued a first Office action final rejection to the RCE. The examiner finally rejected all pending claims 1, 3, 4, 6-8, 10-15 and 17-24 under applicable sections of 35 U.S.C. § 102 and § 103 based on the references to Pribil (U.S. 1,530,324), Kazokas (U.S. 3,061,416) and design choice.

On Dec. 18, 2007, the petitioner filed the current petition requesting supervisory review of the propriety of the final rejection and withdrawal of the finality of the office action dated Nov. 21, 2007 pursuant to MPEP § 706.07(d) and issuance of a non-final office action. The petitioner is of the opinion that the first Office action final rejection of Nov. 21, 2007 was improper under MPEP § 706.07(b), claims filed in the amendment of Oct. 31, 2007 changed the scope of the claims from the previously filed claims so that they are not drawn to the same invention, and the claims presented on Oct. 31, 2007 could not have been finally rejected on the grounds and art of record in the next office action if they had been entered in the application earlier under 37 CFR § 1.114. Petitioner has noted that the amended independent claim 17 adds the limitation "at least one of the rings having generally circular inner surface". In addition, it has been noted that new dependent claims 22-24 have been added, in which claim 22 includes the additional limitation added to claim 17, and claims 23 and 24 include the additional limitation "each ring is in a plane perpendicular to the length of the tubular member". On November 21, 2007, the Examiner issued a first Office action that was made final.

Analysis of Application Record

In the earlier final rejection of Sep. 17, 2007, claims 1, 3, 4, 6, 11-13 and 21 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Pribil (U.S. 1,530,324). Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Pribil in view of Kazokas (U.S. 3,061,416). Claims 7, 8, 10, 14-15 and 18-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pribil in view of design choice. In response to the final rejection, on Oct. 31, 2007 the applicant filed the current RCE with an amendment to amend the independent claim 17 and added dependent claims 22-24. The amendment submitted added additional dependent claims 22-24 and the limitation "at least one of the rings having generally circular inner surface" to claim 17. Apparently, the claims as amended in the amendment of Oct. 31, 2007, fails to define over the prior art references. The first Office action final rejection was issued on Nov. 21, 2007. This final rejection is based on the same prior art patents under the same applicable statutes of 35 USC § 102(b) and §103 with the contents substantially the same as the previous final rejection mailed Sep. 17, 2007.

Petitioner opines that the amendment would not have been properly finally rejected on the grounds and art of record in the next Office action if they have been entered in the earlier application, because neither "at least one of the rings having generally circular inner surface" nor "each ring being in a plane perpendicular to the length of the tubular member" has been disclosed or taught in the Pribil reference (U.S. Patent No. 1,530,324). This line of argument is not convincing because the final rejection of Nov. 21, 2007 was based on the same prior art patents under the same applicable statutes of 35 U.S.C. 102(b) and 103 with the contents substantially the same as the previous final rejection mailed Sep. 17, 2007. This clearly shows the amendment filed with the RCE on Oct. 31, 2007 is directed to the same invention as claimed previously.

Decision

Based on the analysis of record, when the examiner promulgated the first Office action final rejection of Nov. 21, 2007, the conditions set forth in MPEP § 706.07(b)¹ were met. In particular, the amended and added claims in the amendment of Oct. 31, 2007, in fact, are directed to the same invention as the claims in the earlier amendment filed on Aug. 29, 2007 as indicated by the scope of the claims and the contents of the rejections. The claims in the amendment of Oct. 31, 2007 would have been properly finally rejected on the same grounds and art of record in the next Office action if they had been filed earlier. Therefore, under MPEP § 706.07(b) the first action final rejection of Nov. 21, 2007 is deemed proper.

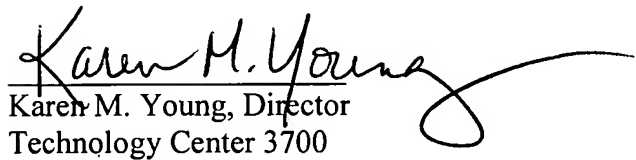
¹ **706.07(b) Final Rejection, When Proper on First Action [R-1]**

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. A first Office action in a continuing or substitute application may not be made final if it contains a new ground of rejection necessitated by the amendments to 35 U.S.C. 102 (e) by the Intellectual Property and High Technology Technical Amendments of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)). However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised. Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application. A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.

For the foregoing reasons it appears that the examiner did not abuse his discretion, or act in an arbitrary or capricious manner, in making the Nov. 21, 2007 Office action final. Therefore, there is no basis for granting any of the relief requested.

The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3748 pending the filing of a proper reply to the final rejection. See relevant provisions of 37 CFR §§ 41.31, 1.113, 1.114 and 1.116. Petitioner is reminded that the period for filing such reply remains as set forth in the final rejection notwithstanding the filing of the instant petition. Petitioner may file a request for reconsideration of this decision, without fee. However, such request must be filed within two months of the date of this decision. See 37 CFR § 1.181(f). Should petitioner have any further questions, he is invited to contact Henry Yuen, TC 3700 SPRE, at 571-272-4856.

PETITION DISMISSED


Karen M. Young, Director
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